

REMARKS

Specification Objected to

The examining attorney has objected to the specification based on three informalities, and Applicant has made the corrections requested, thereby removing the objections.

Section 112 First Paragraph Rejection

The examining attorney has rejected claims 1, 2, 4, 5, 10, and 12-17, as containing subject matter not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1, 14, 15 and 23 state "predetermined" and the examiner states that the specification fails to disclose the predetermined identifier labels and ultraviolet detectable particles.

In response thereto, Applicant states that there is antecedent basis in several locations in the specification, as shown below, and therefore requests that the objection be removed:

In the specification at page 9, paragraph 9:

One embodiment of this invention for example involves an identifier label container for use in combination with a source of dynamic fluid which provides a force to apply identifier labels to an article, the container comprising: a container with a plurality of predetermined identifier labels therein; a discharge aperture in fluid communication with the container; and a fluid intake aperture configured to receive the source of dynamic fluid and to direct it to the discharge aperture; such that once the plurality of predetermined identifier labels are mixed with a base fluid to form

a mixture, the mixture may be discharged through the discharge aperture.

Examples of some other or further embodiments may include embodiments or configurations: wherein the container is disposed to receive dynamic fluid; wherein the identifier labels are comprised of a DNA identifier; the base fluid is an adhesive; the base fluid is a paint; the base fluid includes DNA molecules; the base fluid includes predetermined ultra violet detectable particles or molecules; the dynamic fluid is air; and in which there is a dynamic fluid conduit disposed to deliver dynamic fluid to the container.

In the specification at page 3, paragraph 15:

The term identifier label includes identifiers, identifier labels, identifier particles and identifying indicia, and as used herein is not limited to any specific one type of particle, label or identifier, but instead is each meant to include all unique identifiers, identifier particles and identifiable labels, including without limitation, micro-labels, DNA identifiers, synthetic DNA labels, biological elements, rare earth minerals utilized for tracing (such as those minerals and services offered by Austguard of Perth Australia), UV detectable particles or substances, micro dots, data dots, unique or identifiable chemical compounds and others.

Section 112 Second Paragraph Rejection

The examining attorney has rejected claims 1, 2, 4, 5, 10, 12, 13, 15-17 and 20-23, as being indefinite under Section 112, Second Paragraph.

The examiner asserts that in claims 1 and 15 and 23, it is uncertain whether applicant is claiming a combination of a container, identifier labels an, discharge aperture, and fluid intake aperture or the sub-combination of a container. In response thereto, applicant has amended the claims to recite "applicator" instead of container, as shown in the claims.

The examiner asserts that claim 1 recites the limitation "a plurality of predetermined identifier labels" in line 4, which appears to be a double inclusion of "identifier labels" recited in line 2". In response thereto, applicant has amended the claims to clarify the labels.

The examiner asserts that claim 10 recites the limitation "the cross sectional area" in lines 3-4, with no antecedent basis. In response thereto, applicant has amended the claim to removed the rejection.

The examiner asserts that claim 10 recites the limitation "the bottom" in line 4, with no antecedent basis. In response thereto, applicant has amended the claim to removed the rejection by restating bottom to "bottom side" in claim 10.

The examiner asserts that in claim 13 it is uncertain whether applicant is claiming a combination of a container, identifier labels, discharge aperture, fluid intake aperture and dynamic fluid conduit or the subcombination of a container. In response thereto, has amended the claim to more clearly reflect the subject of the claim.

The Section 102 Anticipation Rejection: Inglis

The examining attorney has rejected claims 1, 2, 4, 5, 10, 13-17, 21 and 23 as being anticipated by Inglis '101. The applicant has considered the rejection and respectfully disagrees as set forth below.

The applicant submits that Inglis '101 does not anticipate this invention as there is no suggestion or teaching in Inglis that it is capable of applying identifier labels, there is no recited element of a plurality of labels mixed with a base fluid to form a mixture. Furthermore in Inglis, the base fluid is the same as the dynamic fluid, whereas in this application as amended, the two are dissimilar.

Still further, Inglis does not disclose, teach or suggest an identifier label or a mixture of an identifier label with a base fluid.

The foregoing lead to the conclusion there is no anticipation for the following reasons:

1. Inglis '101 is not known or capable of performing the function of this invention, nor does it teach the disclosure of this invention. There is no anticipation by a prior patent not known or recognized as being capable of performing the function of the patented device, but rather the prior patent must itself do the teaching. RCA Corp. V. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 U.S.P.Q. 385 (1984); Edstrom-Carson & Co. V. Onsrud Machine Works, Inc., 129 U.S.P.Q. 457.

2. Inglis '101 does not disclose the purpose, means or mechanism that this invention discloses, as set forth above. There is no anticipation where a reference does not disclose the purpose, means and mechanism for accomplishing the instant invention but rather is restricted to a limited and different means. Sperry Products, Inc. V. Aluminum Company of America, 120 U.S.P.Q. 362.

3. Inglis '101 does not solve the problems this invention solves and there is no suggestion it does. There is no anticipation if a prior patent does not solve the problem(s) which the subsequent patent successfully solves. Technical Development Corporation v. Servo Corporation of America, 125 U.S.P.Q. 133.

4. The Inglis '101 reference does not disclose each and every element of the claimed invention, as required for a *prima facie* case of anticipation, and as stated more fully above. There is no anticipation if the reference does not disclose each and every element of the claimed invention. SSIH Equipment S.A. v. United States International Trade Commission, 718 F.2d 365, 218 U.S.P.Q. 678 (1983).

The Section 102 Anticipation Rejection: McRitchie

The examining attorney has rejected claims 1, 2, 4, 5, 10, 12-17, 21 and 23 as being anticipated by McRitchie '459. The applicant has considered the rejection and respectfully disagrees as set forth below.

First of all, the same rationale and reasons apply to McRitchie as did to Inglis, and are hereby incorporated herein by this reference. Further, McRitchie does not disclose, teach or suggest an identifier label or a mixture of an identifier label with a base fluid. The container is described as a material hopper and nothing more.

The applicant submits that McRitchie '459 does not anticipate this invention for the following reasons:

1. McRitchie '459 is not known or capable of performing the function of this invention, nor does it teach the disclosure of this invention.
2. McRitchie '459 does not disclose the purpose, means or mechanism that this invention discloses;
3. McRitchie '459 does not solve the problems this invention solves;
nad
4. McRitchie '459 does not disclose each and every element of this invention.

The examiner has not therefore made out a prima facie case of anticipation and the applicant respectfully requests reconsideration of the McRitchie rejection.

Obviousness - Section 103(a) Rejection

The examining attorney has rejected claim 20 as being obvious over McRitchie '459 in view of Healey '918.. Applicant respectfully requests the examiner to reconsider said objection based on the arguments submitted above relative to the anticipation rejections, and the arguments presented below.

Applicant requests the Examiner reconsider the rejection because there is nothing in the McRitchie '459 reference which suggests the desirability of the

combination and therefore the Examiner has not met the minimum required showing for *prima facie* obviousness.

In the U.S. Court of Appeals for the Federal Circuit case of *In Re: Lee*, 61 U.S.P.Q. 2d 1430, decided January 18, 2002, the Federal Circuit held:

... Thus, when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The Board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

The examining attorney has therefore failed to meet the requirement to set forth with specificity the general knowledge in the art to enable a finding that the person having ordinary skill in the art would make such combination.

As the PTO recognizes in MPEP 2142:

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process.... The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of

obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of non-obviousness.... The initial evaluation of *prima facie* obviousness thus relieves both the Examiner and Applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention.

MPEP 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re: Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Federal Circuit has several times expressly addressed the issue of how to evaluate an alleged case of *prima facie* obviousness to determine whether it has been properly made. Thus, *In re: Geiger* stated in holding that the PTO “failed to establish a *prima facie* case of obviousness:

Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ADC Hospital Systems, Inc. V. Monteffore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Prior Art Made of Record and Not Relied Upon


The Applicant notes the prior art made of record but not relied upon and asserts that for the reasons set forth above, the claims are allowable over the art made of record.

Conclusion

Applicant therefore submits Claims 1, 2, 4, 5, 10, 12-17, and 20-23 are in a position to proceed to allowance.

Respectfully submitted,

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By: 
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Application Serial No. 09/715,864
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Inventor McLaws, et al.
Assignee N/A
Group Art Unit 3752
Examiner Christopher S. Kim
Attorney's Docket No. MC57-001
Title: Identifier Label Application System

VERSION WITH MARKINGS TO SHOW CHANGES MADE ACCOMPANYING
RESPONSE TO August 15, 2002 OFFICE ACTION

In the Specification

The replacement specification paragraphs incorporate the following amendments. Underlines indicate insertions and ~~strikeouts~~ indicate deletions.

The paragraph beginning at line 14 on page 6 has been amended as follows:

Figure 2 is a cross-sectional view of another example of an embodiment of this invention, illustrating a more self contained embodiment of an applicator 150, which only requires a source of a dynamic fluid (in this embodiment, compressed air). Figure 2 illustrates container 151 with a hemispherical bottom portion 151a, with a mixture 176a of identifier labels 174 and base liquid 175. The mixture ~~476~~ 176a may be prepackaged or the base fluid 175 may be later added.

The paragraph beginning at line 4 on page 7 has been amended as follows:

Valve 157 controls the flow of the compressed air 159 through conduit 158 and into the mixture ~~176~~ 176a of identifier labels 174 and base fluid 175, and provides an agitation or mixing of the identifier labels 174 with the base fluid 175.

The paragraph beginning at line 7 on page 7 has been amended as follows:

As discharge valve 170 is opened, compressed air flows out discharge aperture 152 and draws the mixture ~~176~~ 176a through conduit 173 and into the discharge aperture 152. The mixture 176b provided to the discharge aperture is shown, as is the mixture 176c exiting the discharge aperture 152.

In the Claims

The claims have been amended as follows. Underlines indicate insertions and ~~strikeouts~~ indicate deletions.

1. (Amended) An identifier label ~~container~~ applicator for use in combination with a source of dynamic fluid which provides a force to apply a plurality of predetermined identifier labels to an article, the container comprising:

a container with a the plurality of predetermined identifier labels therein;
a discharge aperture in fluid communication with the container; and
a fluid intake aperture configured to receive the source of dynamic fluid and to direct it to the discharge aperture;
such that once the plurality of predetermined identifier labels are mixed with a base fluid to form a mixture, the mixture may be discharged through the discharge aperture; wherein the base fluid is dissimilar from the dynamic fluid.

2. (Amended) An identifier label ~~container~~ applicator as recited in claim 1, and wherein the container is disposed to receive dynamic fluid.

3. (Amended) An identifier label ~~container~~ applicator as recited in claim 1, and wherein the identifier labels are comprised of a DNA identifier.

4. (Amended) An identifier label ~~container~~ applicator as recited in claim 1, and which is further comprised of a base fluid mixed with the identifier labels in the container.

5. (Amended) An identifier label ~~container~~ applicator as recited in claim 4, and wherein the base fluid is an adhesive.

6. (Amended) An identifier label ~~container~~ applicator as recited in claim 1, and wherein the base fluid is paint.
7. (Amended) An identifier label ~~container~~ applicator as recited in claim 1, and wherein the base fluid is further comprised of a plurality of predetermined DNA particles.
8. (Amended) An identifier label ~~container~~ applicator as recited in claim 1, and wherein the base fluid is further comprised of a plurality of predetermined ultra violet detectable particles.
9. (Amended) An identifier label ~~container~~ applicator as recited in claim 1, and wherein the container is below the discharge aperture and the container has a bottom side which is conical in shape.
10. (Amended) An identifier label ~~container~~ applicator as recited in claim 1, and wherein the container is below the discharge aperture, and further wherein the container has a bottom side with a cross-sectional area which is less than ~~the~~ a cross-sectional area of portions of the container above the bottom side.
11. (Amended) An identifier label ~~container~~ applicator as recited in claim 1, and wherein the container is collapsible.

12. (Amended) An identifier label ~~container~~ applicator as recited in claim 1, and wherein the dynamic fluid is air.

13. (Amended) An identifier label ~~container~~ applicator as recited in claim 1, and further comprising a dynamic fluid conduit disposed to deliver dynamic fluid to the container.

14. (Amended) An identifier label applicator for use in combination with a source of dynamic fluid, the applicator comprising:

an applicator framework;

a container operatively attached to the framework and including a plurality of predetermined identifier labels therein;

a discharge aperture in fluid communication with the container such that it may receive identifier labels from the container; and

a fluid intake aperture operative attached to the framework and configured to receive dynamic fluid and direct it to the discharge aperture; and

such that once the plurality of predetermined identifier labels are mixed with a base fluid to form a mixture, the mixture may be discharged through the discharge aperture; wherein the base fluid is dissimilar from the dynamic fluid.

15. (Amended) A method for applying identifier labels to one or more articles, comprising the following steps:

providing an identifier label ~~container~~ applicator for use in combination with a source of dynamic fluid, the container comprising:

a container with a plurality of predetermined identifier labels therein;

a discharge aperture in fluid communication with the container; and

a fluid intake aperture configured to receive the source of dynamic fluid and to direct it to the discharge aperture;

mixing the identifier labels with a base fluid to form a mixture;

providing dynamic fluid through the discharge aperture wherein the base fluid is dissimilar from the dynamic fluid; and

thereby discharging the mixture through the discharge aperture.

16. A method for applying identifier labels to one or more articles as recited in claim 15, and further comprising the following steps of:

providing a dynamic fluid conduit disposed to deliver dynamic fluid to the container; and

delivering dynamic fluid into the mixture, thereby causing movement of the mixture and a mixing of the base fluid and the identifier labels.

17. A method for applying identifier labels to one or more articles as recited in claim 15, and wherein the base fluid is an adhesive.

18. A method for applying identifier labels to one or more articles as recited in claim 15, and wherein the base fluid is a paint.

19. A method for applying identifier labels to one or more articles as recited in claim 15, and wherein the identifier labels are comprised of DNA identifiers.

20. A method for applying identifier labels to one or more articles as recited in claim 15, and wherein the identifier labels are comprised of a plurality of ultra violet detectable particles.

21. A method for applying identifier labels to one or more articles as recited in claim 15, only wherein container is further provided with a base fluid which is mixed with the plurality of predetermined identifier labels.

22. A method for applying identifier labels to one or more articles as recited in claim 15, and wherein the dynamic fluid is air.

23. (Amended) An identifier label ~~container~~ applicator comprising:
a container with an internal cavity in which there is a pressurized mixture of a plurality of predetermined identifier labels and a base fluid;
a discharge aperture in fluid communication with the internal cavity of the container; and

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a container valve in fluid communication with the internal cavity and which is disposed to release the mixture from the internal cavity upon activation of the container valve to a desired location.

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